

REMARKS

This Response is submitted in reply to the Office Action dated April 28, 2006. Claims 1-93 have been canceled without prejudice or disclaimer. New Claims 94-114 have been added. No new matter has been added to the Claims. A Supplemental Information Disclosure Statement and a Petition for one-month extension of time are submitted herewith. Please debit Deposit Account No. 02-1818 for any fees due in connection with this Response.

1. New Claims

Applicants have voluntarily canceled Claims 1-93 and added new Claims 94-114. The purpose for such amendment is to change the focus of the claimed subject matter. Applicants did not make such amendment to overcome or address any rejection in the Office Action. No new matter has been added through such amendment. Applicants respectfully submit that new Claims 94-114 are in condition for allowance.

2. Claim Rejections – 35 U.S.C. §112

The Office Action rejected Claims 72-81 under 35 U.S.C. §112, second paragraph, stating that the language “separate recording member connected to the body” is confusing. Applicants have canceled Claim 72 for the reasons provided above.

3. Claim Rejections – 35 U.S.C. §102

3.1 Takemoto 082

The Office Action rejected Claims 1-24, 38-69, 71 and 82-93 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,683,082 to Takemoto et al. (“Takemoto 082”). The Office Action also rejected Claims 25-37, 70 and 72-81 under 35 U.S.C. §102(b) as being anticipated by Takemoto 082. Although Applicants have canceled such Claims for the reasons provided above, Applicants respectfully disagree with such rejection for the reasons set forth below.

Each of the rejected Claims 1-24, 38-71, and 82-93 includes an element relating to causing at least one of the received data cards or received data cards to be stored within the housing of the gaming device.

The Office Action asserted that Takemoto 082 teaches instructions to "store the received data card within the housing if no credits remain and if credits remain . . . move the received data card to a card holder." Based on Applicants' review, Takemoto 082 does not appear to make such disclosure.

For the rejection of Claims 1-24, 38-69, 71 and 82-93, the Office Action relied upon Section 2131.01 of the Manual of Patent Examining Procedure ("MPEP") and U.S. Patent No. 5,628,685 to Takemoto et al. ("Takemoto 685"). The Office Action stated that:

Takemoto '685 . . . is provided as evidence of enablement within Takemoto '082 or to storing/holding data card upon differing events such as cash-out or zero balance. MPEP 2131.01. Essentially, Takemoto '685 either records/prints adjustment value upon a stored card from card stack where the play began with cash inserted or records/prints adjustment value upon the received card being mechanically held where play began from an inserted data card upon receipt of a cash-out or adjustment switch activation as predetermined event, but either does not provide a card upon a zero balance or retains card upon a zero balance. Takemoto '685 is submitted as evidence to show enablement within Takemoto '082 or to show that a characteristic not present is inherent in Takemoto '082 (sic).

Subsection I of Section 2131.01 of the MPEP, entitled "To Prove Reference Contains An Enabled Disclosure," states that "[w]hen the claimed invention or machine is disclosed identically by the reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure." (Emphasis Added). Applicants submit that Takemoto 082 at least does not identically disclose the element of the rejected Claims described above. Takemoto 082 states that "[i]f a game is started with only cash or gaming medals input without a magnetic card, at the time of adjustment the data of the remaining amount, the number of the finally won pinballs, etc., can be written onto one of the magnetic cards held in the stack section and the card then dispensed." (Takemoto 082, Column 8, Lines 22-27). (Emphasis Added). Though Takemoto 082 discloses this concept, Takemoto 082 does not disclose the concept of storing received data cards. Accordingly, Takemoto 082 does not identically

disclose the claimed subject matter. Therefore, Applicants respectfully submit that the Office Action's reliance on Subsection I of Section 2131.01 of the MPEP is improper.

Subsection I of Section 2131.01 of the MPEP, entitled "To Show That A Characteristic Not Disclosed In The Reference Is Inherent," states that "[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." (Emphasis Added).

Takemoto 082 states the following:

The card inlet/outlet 29, which is used to receive and dispense a prepaid card used in place of cash or to dispense an adjustment card, is connected to the card processor 5a (not shown in FIG. 3) provided in the gaming machine. The card processor 5a has a magnetic card drive having read and write functions, for example; it reads the amount data recorded on a magnetic card input through the card inlet/outlet 29 and sends it to the game controller 14 at the appropriate time. At the time of adjustment, it has a function of writing data of the remaining amount, the number of finally won pinballs, etc., onto the card and then dispensing the card.

The card processor 5a contains a magnetic card stack section (not shown) for holding a plurality of magnetic cards and a card dispensing mechanism (not shown). If a game is started with only cash or gaming medals input without a magnetic card, at the time of adjustment the data of the remaining amount, the number of finally won pinballs, etc., can be written onto one of the magnetic cards held in the stack section and the card then dispensed.

The card processor 5a allows not only magnetic cards, but also receipts or the like on which data is visually recorded, to be used as input/output media. For example, a card processor may be used which uses magnetic cards only as card-like recording media for inputting amount data and receipts or the like on which data is printed, or for outputting data of the number of finally won pinballs. Also, a card processor may be used which uses recyclable cards on which characters, etc., can be represented and erased as a result of a temperature change (cards proposed by the applicant in Japanese Patent Application No. Hei 3-260879) as card-like recording media. (Takemoto 082, Column 8, Lines 8-39).

For the function of these card concepts of Takemoto 082, Applicants see no necessity for Takemoto 082's gaming machine to store the received data card. Takemoto 082's gaming machine could, for example, function by personnel periodically loading stacks of cards into the gaming machine. Applicants submit that Takemoto 685

does not provide any evidence of such a necessity. Therefore, Applicants respectfully submit that the Office Action's reliance on Subsection III of Section 2131.01 of the MPEP is improper.

3.2 Takemoto 685

The Office Action rejected Claims 1-19, 22-24, 38, 44-45, 51-52, 58-59, 65-69 and 82-93 under 35 U.S.C. §102(b) as being anticipated by Takemoto 685. Although Applicants have canceled such rejected Claims for the reasons set forth above, Applicants respectfully disagree with such rejection.

4. Claim Rejections – 35 U.S.C. §103

Under 35 U.S.C. §103(a), the Office Action rejected:

(a) Claims 1-24, 38-69, 71 and 82-93 under 35 U.S.C. §103(a) as obvious over Takemoto 082 in view of Takemoto 685;

(b) Claims 25-37, 70 and 72-81 under 35 U.S.C. §103(a) as being obvious over Takemoto 082 in view of U.S. Patent No. 5,179,517 to Sarbin ("Sarbin"), or in the alternative, as being unpatentable over Takemoto 082 in view of Takemoto 685 or, in the alternative, as being unpatentable over Takemoto 082 in view of Takemoto 685 and further in view of Sarbin;

(c) Claims 20-21, 39-43, 46-50, 53-57 and 60-64 as being unpatentable over Takemoto 685 in view of Takemoto 082; and

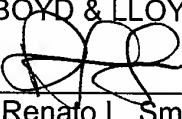
(d) Claims 25-37, 70 and 72-81 under 35 U.S.C. §103(a) as being unpatentable over Takemoto 685 in view of Sarbin.

Although Applicants have canceled such rejected Claims for the reasons set forth above, Applicants respectfully disagree with such rejections.

An earnest endeavor has been made to place this application in condition for allowance, and such allowance is courteously solicited. If the Examiner has any questions related to this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,
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